

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Robert A. MacDonald
Robert J. Race

Attorney Docket: KEY1019US

Serial No.: 09/312,352

Group: 3672

Filed: May 14, 1999

Examiner: Theresa M. Wesson

For: Retaining Wall Block

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TRANSMITTAL LETTER

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Assistant Commissioner for Patents
Washington, D.C. 20231
Attention: Licensing and Review

GROUP 3600

SEP 30 1999

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Dear Sir:

Transmitted herewith are the following:

1. Renewal of Petition for Retroactive Foreign Filing License (2 pages); and
2. Supplemental Declaration of William B. Dawson (1 page) with attachment (3 pages).

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Also enclosed is a check in the amount of \$130.00 to cover the fee for the petition under 37 C.F.R. § 1.17(h).

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Certificate of Mailing/Transmission (37 C.F.R. § 1.8(a))

I hereby certify that this document is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on

Date: September 21, 1999

Signature: Jodi Jung

Name: Jodi Jung

Transmittal Letter
Applicants: MacDonald et al.
Serial Number: 09/312,352

Attorney Docket: KEY1019US

It is believed that no additional fees are due in connection with this Petition. If this is incorrect, however, please charge any additional fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

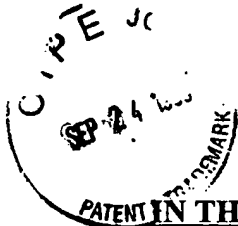
Respectfully submitted,

Dated: 9/21/99

By Terry L. Wiles

Terry L. Wiles, Esq. (29,989)
Patrick J. O'Connell, Esq. (33,984)
Miriam G. Simmons (34,727)
POPOVICH & WILES, PA
IDS Center, Suite 1902
80 South 8th Street
Minneapolis, MN 55402
Telephone: (612) 334-8989
Representatives of Applicants

GROUP 3600
OCT 12 1999
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PATENT IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Robert A. MacDonald
Robert J. Race

Attorney Docket: KEY1019US

Serial No.: 09/312,352

Group: 3672

Filed: May 14, 1999

Examiner: Theresa M. Wesson

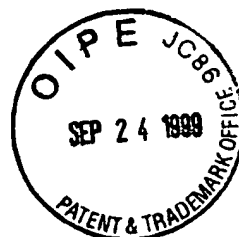
For: Retaining Wall Block

**RENEWAL OF PETITION FOR
RETROACTIVE FOREIGN FILING LICENSE**

Assistant Commissioner for Patents
Washington, D.C. 20231
Attention: Licensing and Review

GROUP 3600

SEP 30 1999



Dear Sir:

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In response to the Decision on Request for Retroactive License Under 37 C.F.R. § 5.25, received August 30, 1999, Applicants hereby renew their petition for a retroactive foreign filing license under 35 U.S.C. § 184 for the patent application entitled "Retaining Wall Block". The petition was denied as being defective for not satisfying the requirements set forth in 37 C.F.R. § 5.25 (a)(3)(ii), specifically that no circumstances nor dates were mentioned regarding the diligent pursuit of foreign filing license. Applicants submit herewith a Supplemental Declaration from William B. Dawson indicating both the circumstances and pertinent dates on which actions were taken to pursue the foreign filing license.

In accordance with 37 C.F.R. § 5.25, the following information is provided:

The application was filed in Australia on October 13, 1998 and was granted Australian Provisional Patent Application No. PP6472.

Certificate of Mailing/Transmission (37 C.F.R. § 1.8(a))

I hereby certify that the document is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on

Date: September 21, 1999

Signature: Jodi Jung

Name: Jodi Jung

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The same application was filed with the Gulf Cooperation Council (covering member states Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and The United Arab Emirates) on December 22, 1998 and was granted GCC Patent Application No. GCC/P/98/00053.

The following enclosures are included:

1. A Supplemental Declaration of William B. Dawson, with enclosures.
2. A check in the amount of \$130.00 to cover the fee for the petition under 37 C.F.R. § 5.25 as set forth in 37 C.F.R. § 1.17(h).

A copy of the Australian application No. PP6472 was included with the petition filed with the U.S. Patent Office on June 10, 1999.

Applicants submit that this declaration clearly delineates the diligence made in obtaining the foreign filing license, and respectfully request that the petition be granted.

It is believed that no additional fees are due in connection with this Petition. If this is incorrect, however, please charge any additional fees to our Deposit Account No. 16-2312. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our deposit account.

Respectfully submitted,

Date: 7/20/99

By Terry L. Wiles

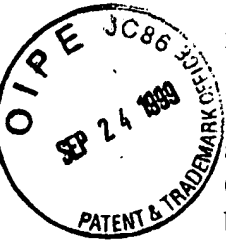
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Miriam G. Simmons (34,727)
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Representatives of Applicants

SUPPLEMENTAL DECLARATION OF WILLIAM B. DAWSON

I, William B. Dawson, wish to supplement my earlier Declaration dated May 25, 1999, in order to specifically respond to the Decision denying the Petition for retroactive license regarding patent application Serial No. 09/312,352. In that decision, the petition was held defective since the circumstances regarding the diligent pursuit of the foreign filing license (37 C.F.R. § 5.25(a)(3)(ii)) were not delineated.

I did not become aware of any problem with the foreign filing license until approximately March 30, 1999. Sometime in March I telephoned our Australian attorney Greg Gurr at Spruson & Ferguson and requested that an international application (PCT) based on the Australian application be filed. I received a letter from him via facsimile on March 30, 1999 indicating that the PCT filing would have to be done from the U.S. and that likely we would need a foreign filing license for the PCT application. On April 1, I faxed a copy of this letter to our U.S. attorneys, Popovich & Wiles, with a handwritten note requesting the filing of a PCT application out of the U.S. and requesting a phone call to discuss the situation. (A copy of the letter and handwritten note are attached hereto). Within the next few days or so thereafter I was contacted by Terry Wiles of Popovich & Wiles. He informed me that a foreign filing license should have been obtained prior to the filing of the Australian and Gulf Cooperation Council (GCC) applications. He advised that it would be necessary that a petition to obtain a retroactive foreign filing license be filed. He told me that to do so he would need to obtain additional information regarding the Australian and GCC applications from the attorneys that filed them and that he would need to do some research of the law and procedures for obtaining a retroactive foreign filing license. I authorized him to take whatever steps were necessary to obtain the retroactive license. During the course of the next several weeks I periodically spoke with Terry Wiles regarding the status of his efforts to obtain information concerning the Australian and GCC filings. He obtained the information necessary by early May 1999 and the U.S. application corresponding to the Australian and GCC applications was filed May 14, 1999. He also prepared a draft of a declaration to submit with the petition for retroactive license. I reviewed the draft and provided my comments and a final version was prepared and signed by me on May 25, 1999. At that time Mr. Wiles told me the petition would be filed as soon as he received a serial number for the U.S. application from the U.S. Patent Office. Within the next few days thereafter the serial number was received. The petition and supporting documents were then prepared and the petition was filed on June 10, 1999.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date 9/10/99By William B. Dawson
William B. Dawson



FAX MEMO

The First To Last.

To: Terry Wiles

Date: 4-1-99

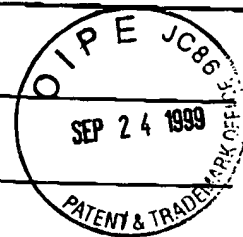
Company: Popovich & Wiles

From: William Dawson

Fax No: 334-8994

Total Pages: 3

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4444 West 78th Street Minneapolis, MN 55435 612/897-1040 612/897-3858 FAX

SPRUSON & FERGUSONPATENT AND TRADE MARK ATTORNEYS SINCE 1887
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+61 2 9261 5486TELEPHONE : +61 2 9207 0777
E-MAIL : mail@sprusons.com.au

30 March, 1999

To : Keystone Retaining Wall Systems, Inc.
Address : 4444 West 78th Street
Minneapolis Minnesota 55435
UNITED STATES OF AMERICACopy To: Keystone Retaining Wall Systems
11A Gardenvale Road
Oatlands New South Wales 2117
AUSTRALIA

Fax No : +1 612 897 3858

Fax No: (02) 9898 0885

Pages : 2, including this page.

This facsimile is only for the use of the individual or entity to whom it is addressed and contains information which may be confidential and the subject of legal privilege. If you receive this communication in error, please destroy it and notify us immediately by fax or telephone. Thank you.

Attention: Mr Bill Dawson
Corporate Counsel

Attention: Mr Peter Harries

Our Ref: 430248:GJG
Your Ref: Compac Lite Block

Dear Mr Dawson

Re : Australian Provisional Patent Application No. PP6472
Keystone Retaining Wall Systems, Inc.

Further to our telephone conversation of this morning (yesterday evening your time), I advise that there will be some difficulty in having us preparing and filing a PCT International Application in respect of the "Compac Lite Block", currently the subject of the above Australian provisional patent application.

The PCT requires that an International Application be filed with the National Patent Office of or acting for the country of which the applicant is a resident or national, or with the International Bureau in Geneva.

With the applicant, Keystone Retaining Wall Systems, Inc., being a US corporation, it will be necessary to have the PCT International Application filed with the USPTO. We are only able to file the application with the Australian Patent Office if the applicant is a national or resident of Australia. Perhaps it would be most appropriate for you to instruct Popovich & Wiles, who we understand have filed the corresponding US application, to attend to preparation and filing of the PCT application.

The only way in which we would be able to prepare and file a PCT application with the Australian Patent Office is if an Australian resident or national were listed as an applicant. This could be achieved by having rights in the invention assigned to an Australian resident or national for the purposes of at least one country designated on the PCT request form. The PCT Application would then have an Australian applicant and we would be able to file with the Australian Patent Office. If you wish us to pursue this option, it would be appropriate to list an

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Keystone Retaining Wall Systems, Inc.

Our Ref: 430248:GJG

Australian national/resident as applicant for one of the more obscure PCT countries in which you do not intend pursuing entry of the National Phase and obtaining a patent for the invention. We would propose to use Mongolia for such a purpose. If you wish us to proceed in this manner, perhaps it would be appropriate to list Mr Peter Harries as applicant for such a "dummy" country to qualify us to file the application in Australia.

If you wish us to prepare and file the application, we will require an advance payment to the value of AU\$10,000 to cover our costs including the payment of official fees. We would then designate all countries available with the exclusion of the USA, with the US application having already been filed.

Whilst reviewing our file, it has come to our attention that it may be appropriate to obtain a foreign filing licence from the USPTO before filing the PCT application, assuming the invention was conceived in the US. Perhaps such a foreign filing licence should also be obtained in relation to the Australian and Gulf Cooperation Council applications already filed. We suggest you liaise with Popovich & Wiles to discuss the requirements of the foreign filing licence.

Mr Harries has advised during several previous telephone conversations that he wishes to seek protection for the Compac Lite Block in various countries, some of which may not be party to the PCT. Assuming these non-PCT countries are party to the Paris Convention, or afford the equivalent of Convention priority, then it will be appropriate to file applications directly in these countries before the 13 October 1999 priority deadline. We advise that Taiwan and Thailand are two such countries which are not party to the PCT. We look forward to your instructions in due course and as to which other countries you are interested in seeking protection in.

We look forward to receipt of your further instructions.

Yours sincerely

SPRUSON&FERGUSON


Greg Gurr

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